

Atty Dkt. No.: 10971150-2
USSN: 10/080,641

REMARKS

In view of the following remarks, the Examiner is requested to allow Claims 32, 33, 36-38 and 43-61, the only claims pending and under examination in this application.

Claims 32, 38, 47 and 53 have been amended to indicate that the detector system is configured for receiving a constructively interfering emission from an array having a reflective coating. Support for these amendments can be found throughout the specification and claims as originally filed. For instance, support can be found at page 17, line 3 to line 22. Claims 59 to 61 have been added. Support for new Claim 59 may be found at page 17, line 3 to line 22. Support for new Claim 60 may be found at page 5, lines 15 to 20. Support for new Claim 61 may be found at page 3, lines 11 to 13. Accordingly, no new matter has been added.

As no new matter has been added by way of these amendments, entry thereof by the Examiner is respectfully requested.

Claim Objections

Claim 53 has been objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of Claim 47 from which it depends.

The Office alleges that Claim 53 does not set forth proper structural elements that differentiate Claim 53 over the claim from which it depends.

The Applicants have amended Claim 53 to depend from Claim 43 and to clarify that the detector is configured for receiving a constructively interfering emission. The Applicants would like to draw the Office's attention to *In re Venezia*, where in the use of "adapted for" language was found to be an appropriate manner in which to define the structure of an assembly.

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In *In re Venezia* the Appellant's invention was for a splice connector kit with interrelated parts to be assembled in the field and used with high voltage shielded electric cables. The parts of the kit were claimed with respect to how they were adapted (e.g., configured) to interact with one another in the final assembly. The Court found that there is:

"nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly." *In re Venezia*, 189 U.S.P.Q. (BNA) 149 (1976).

Accordingly, the Applicants contend that Claim 53 is in proper dependent form in accordance with 37 C.F.R. 1.75(c) in that it differentiates the detector system of Claim 53 from that of Claim 43 in that the detector system of Claim 53 is configured for receiving a constructively interfering emission from an array having a reflective coating. Therefore, in light of the above, the Applicants respectfully request that this rejection be withdrawn.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 32, 33, 37, 38, 43, 45-50 and 52-58 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kaye (USPN 3,850,525) and/or Modell *et al.* (USPN 6,826,422) in view of Schultz *et al.* (USPN 6,180,415).

According to the M.P.E.P. § 706.02 (j), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

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With respect to Claims 32, 33, 37, 38, 47-50 and 52-58 an element of the claims as amended is a detector system that is configured for positioning at least one of the more than one detectors at a site for receiving a constructively interfering emission from an array having a reflective coating.

Both Kaye and Modell are deficient because neither reference teaches an apparatus with a detector system that is configured for positioning at least one of the more than one detectors at a site for receiving a constructively interfering emission from an array having a reflective coating. As Schultz was cited solely for its disclosure of a similar system which further includes a processor, it fails to remedy the deficiencies of Kaye and Modell.

None of Kaye, Modell or Schultz suggest a detector system that is configured for positioning at least one detector at a site for receiving a constructively interfering emission from an array having a reflective coating because none of Kaye, Modell or Schultz recognize the problem the Applicants' were trying to solve or appreciate that the problem can be overcome by positioning a detector at a site for receiving a constructively interfering emission from an array.

The Applicants' claimed invention is based in part on an appreciation of the fact that high interrogation light power can be provided without increasing the output of the interrogating light source. Increasing the power of an interrogating light source increases the probability of saturation of a feature. To overcome this problem, the Applicants have developed a method and system where a feature is illuminated simultaneously with an interrogating light which is both reflected and non-reflected from the reflecting layer. Hence, by positioning at least one of the more than one detectors at a site for receiving a constructively interfering emission from an array having a reflective coating the signal to be detected may be increased without increasing the power of the interrogating light source.

None of Kaye, Modell or Schultz recognizes this problem. Hence, without recognizing the particular problem the Applicants are trying to solve none of Kaye,

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Modell or Schultz suggests solving that problem in the manner claimed by the Applicants, namely, by positioning at least one of the more than one detectors at a site for receiving a constructively interfering emission from an array having a reflective coating.

Additionally, outside of the Applicants' own teachings of the problem and its solution, there is no motivation within Kaye, Modell or Schultz to combine the cited references in the manner suggested. In fact, in view of the disclosure of Schultz' which suggests that plasmon resonant particle emission detection can be enhanced by increasing the overall average input power absorption, one of skill would be motivated by Schultz to increase the power of the interrogating light source so as to maximize the overall average input power to be absorbed and thereby better detect plasmon resonant particle emission. See Schultz, column 13, lines 53 to 58. This is in direct opposition to the Applicants' teachings, wherein instead of increasing the power of the interrogating light source a detector is positioned at a site for receiving a constructively interfering emission from an array having a reflective coating so as to increase the signal to be detected.

With respect to Claims 43-46 an element of the claims is a detector that can be moved to align with different detection angles so as to detect different emitted light wavelengths at respective different detection angles. The Office has not set forth where the cited references teach a detector that can be moved to align with different detection angles so as to detect different emitted light wavelengths at respective different detection angles. The Applicants contend that none of Kaye, Modell or Shultz teach or suggest a detector that can be moved to align with different detection angles so as to detect different emitted light wavelengths at respective different detection angles. Additionally, as set forth above, even if the combination were to teach all the elements of the claimed invention, one of skill in the art would not be motivated to combine the cited references in the manner suggested.

In view of the above, the Applicants contend that a *prima facie* case of obviousness has not been established because the combination of Kaye and/or Modell in view of Schultz fails to teach or suggest all the elements of the claimed

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invention and even if all the elements are taught or suggested, there is still no motivation to combine the references in the manner suggested by the Office. Accordingly, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 32, 33, 37, 38, 43, 45-50 and 52-58 be withdrawn.

Claims 36, 45 and 51 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kaye and/or Modell *et al.* in view of Schultz *et al.* as applied to claims 32, 43 and 48 above and further in view of Zeleny *et al.* (USPN 6,215,894).

With respect to Claims 36 and 51 an element of the amended base claims from which these claims depend is a detector system that is configured for positioning at least one detector at a site for receiving a constructively interfering emission from an array having a reflective coating. Kaye, Modell and Schultz are deficient because none of the references teach an apparatus with a detector system that is configured for positioning at least one of the more than one detectors at a site for receiving a constructively interfering emission from an array having a reflective coating. As Zeleny was cited for its disclosure of a bar code reader it fails to remedy the deficiencies of Kaye, Modell and Schultz.

None of Kaye, Modell or Schultz suggest a detector system that is configured for positioning at least one detector at a site for receiving a constructively interfering emission from an array having a reflective coating because none of Kaye, Modell or Schultz recognize the problem the Applicants' were trying to solve or appreciate that the problem can be overcome by positioning a detector at a site for receiving a constructively interfering emission from an array.

As stated above, without recognizing the particular problem the Applicants are trying to solve none of Kaye, Modell or Schultz suggests solving that problem in the manner claimed by the Applicants, namely, by positioning at least one of the more than one detectors at a site for receiving a constructively interfering emission from an array having a reflective coating.

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Additionally, outside of the Applicants' own teachings of the problem and its solution, there is no motivation within Kaye, Modell or Schultz to combine the cited references in the manner suggested. In fact, in view of the disclosure of Schultz' which suggests that plasmon resonant particle emission detection can be enhanced by increasing the overall average input power absorption, one of skill would be motivated by Schultz to increase the power of the interrogating light source so as to maximize the overall average input power to be absorbed and thereby better detect plasmon resonant particle emission. See Schultz, column 13, lines 53 to 58. This is in direct opposition to the Applicants' teachings, wherein instead of increasing the power of the interrogating light source a detector is positioned at a site for receiving a constructively interfering emission from an array having a reflective coating so as to increase the signal to be detected.

With respect to Claim 45, Claim 45 depends from Claim 43. An element of Claim 43 is a detector that can be moved to align with different detection angles so as to detect different emitted light wavelengths at respective different detection angles. The Applicants contend that none of Kaye, Modell, Shultz or Zeleny teach or suggest a detector that can be moved to align with different detection angles so as to detect different emitted light wavelengths at respective different detection angles. Additionally, as set forth above, even if the combination were to teach all the elements of the claimed invention, one of skill in the art would not be motivated to combine the cited references in the manner suggested.

In view of the above, the Applicants contend that a *prima facie* case of obviousness has not been established because the combination of Kaye and/or Modell in view of Schultz and further in view of Zeleny fails to teach all the elements of the claimed invention and even if all the elements are taught or suggested, there is still no motivation to combine the references in the manner suggested by the Office. Accordingly, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 36, 45 and 51 be withdrawn.

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CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 833-7770.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10971150-2.

Respectfully submitted,
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Date: May 16, 2006

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